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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PICKARD, ALISON K

ART UNIT PAPER NUMBER

3673

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,842

Applicant(s)

CORBETT, BRADFORD G.

Examiner

Alison K. Pickard

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Election/Restrictions

1. Claims 7-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8-15-05.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 4 contain the trademark/trade name CHEMGLAZE and ENDURALAST. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a material and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Corbett (6,328,309).

Corbett discloses a method of installing a gasket in a socket end of a pipe comprising the steps of providing a mandrel 17 with an inner end, outer end and cylindrical outer surface; installing a gasket 11 in a first position on the surface, wherein the gasket is coated with a polymeric coating 10; providing a retention member 61 and abutting the gasket; heating the socket end; forcing the heated end over the gasket and retention member to form a groove (Figs. 7-10); cooling the heated end; and retracting the cooled end and gasket from the mandrel (Figs. 11-12). The coating is sprayed onto at least portions of a circumferential area of the elastomeric gasket.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corbett '309 in view of Doolittle (3,827,660).

Corbett discloses various polymeric coatings that can be used (col. 3:54-64). However, Corbett does not specifically disclose the coating is polyurethane and exhibits the claimed cured properties (of claim 2). Doolittle teaches various art equivalent anti-friction polymer coatings, such as PTFE and polyurethane. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use PTFE or polyurethane as such are art equivalent anti-friction coatings.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/715,091. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim the method of installing a gasket in a socket end of a pipe comprising the steps of providing a mandrel with an inner end, outer end and cylindrical outer surface; installing a gasket in a first position on the surface, wherein the gasket is coated with a polymeric coating; providing a retention member and abutting the gasket; heating the socket end; forcing the heated end over the gasket and retention member to form a

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groove; cooling the heated end; and retracting the cooled end and gasket from the mandrel. The coating is sprayed onto at least portions of a circumferential area of the elastomeric gasket. And, the coating is polyurethane.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,328,309 in view of Doolittle '660.

The claims are not patentably distinct from each other because both claim a method of installing a gasket in a socket end of a pipe comprising the steps of providing a mandrel with an inner end, outer end and cylindrical outer surface; installing a gasket in a first position on the surface, wherein the gasket is coated with an anti-friction coating; providing a retention member and abutting the gasket; heating the socket end; forcing the heated end over the gasket and retention member to form a groove; cooling the heated end; and retracting the cooled end and gasket from the mandrel. The coating is sprayed onto at least portions of a circumferential area of the elastomeric gasket. Claim 1 of '309 does not disclose the coating is a polymer. However, claims 5 and 6 suggest a fluoropolymer (PTFE), which is a polymer. Doolittle teaches polymeric coatings, such as PTFE or polyurethane, offer improved anti-friction properties. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use a polymeric (such as polyurethane) coating as the anti-friction coating to improve the installation of the gasket.

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11. Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,676,886 in view of Corbett '309 in view of Doolittle '660.

The claims are not patentably distinct from each other because both claim a method of installing a gasket in a socket end of a pipe comprising the steps of providing a mandrel with an inner end, outer end and cylindrical outer surface; installing a gasket in a first position on the surface, wherein the gasket is coated with an anti-friction coating; providing a retention member and abutting the gasket; heating the socket end; forcing the heated end over the gasket and retention member to form a groove; cooling the heated end; and retracting the cooled end and gasket from the mandrel. The coating is sprayed onto at least portions of a circumferential area of the elastomeric gasket. Claim 1 of '886 does not disclose the use of a polymeric anti-friction coating. Corbett '309 teaches the use of a polymeric anti-friction coating on at least circumferential surfaces of the gasket to improve the manufacture of the pipe/gasket as well as to improve installation on pipes/mandrels. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made modify the gasket of '886 with the coating taught by Corbett '886 to improve the manufacture and assembly. Regarding claims 2-4, Corbett '309 does not teach the use of polyurethane. Doolittle teaches various art equivalent anti-friction polymer coatings, such as PTFE and polyurethane. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use PTFE or polyurethane as such are art equivalent anti-friction coatings.

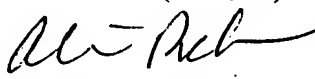
Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on 571-272-7049. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Alison K. Pickard
Primary Examiner
Art Unit 3673

AP